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Filing date: **02/13/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209857
Party	Plaintiff Deford Bailey LLC
Correspondence Address	MARIA A SPEAR AMY J EVERHART EVERHART LAW FIRM PLC 1400 FIFTH AVENUE NORTH NASHVILLE, TN 37208 UNITED STATES maria@everhartlawfirm.com, amy@everhartlawfirm.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Amy J. Everhart
Filer's e-mail	amy@everhartlawfirm.com, maria@everhartlawfirm.com
Signature	/Amy J. Everhart/
Date	02/13/2014
Attachments	Amended.Opposition.Notice.pdf(619327 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Deford Bailey LLC,)
Opposer,) Opposition No. 91209857
)
v.) Application Serial No. 85304626
)
Carlos Deford Bailey) Published in the Official Gazette on
Applicant.) February 19, 2013

AMENDED NOTICE OF OPPOSITION

To the Honorable Commissioner of Patents and Trademarks:

Opposer, Deford Bailey LLC, 4019 Ridgemont Drive, Nashville, TN 37207, believes that it will be damaged by registration of the mark shown in Serial No. 85304626, and hereby opposes the same.

Description of Applicant's Application:

Filing date:	April 26, 2011
Published for Opposition in the Official Gazette:	February 19, 2013
Mark:	DEFORD BAILEY
International Class:	015
Goods and services:	Harmonicas
Claimed date of first use in commerce:	April 11, 2011

As grounds for opposition, Deford Bailey LLC alleges that:

1. Deford Bailey is renowned as the first African-American performer at the Grand Ole Opry in Nashville, Tennessee. Mr. Bailey was a harmonica virtuoso and was inducted posthumously into the Country Music Hall of Fame in 2005. Mr. Bailey died in 1982.

2. Deford Bailey LLC, a Tennessee limited liability company formed on May 28, 2011 (“DB LLC”), is a successor in interest to the name and likeness rights of Deford Bailey.

3. One of the original members of DB LLC was Deford Bailey, Jr., the son of Deford Bailey. Deford Bailey, Jr. contributed and assigned One Hundred Percent (100%) of his interest in and to certain intellectual property, including trademarks, service marks, the names DEFORD BAILEY and DEFORD BAILEY, SR., and all goodwill associated with all such names and marks, and rights of publicity and name and likeness to DB LLC. DeFord Bailey, Jr. passed away in 2013. DB LLC, together with Deford Bailey’s other two children, Christine Lamb and Dezoral Thomas, together own the rights of publicity and name and likeness rights of Deford Bailey (together, the “Heirs”).

4. On April 26, 2011, without seeking consent from the Heirs, Carlos Bailey, a grandson of Deford Bailey, filed with the United States Patent and Trademark Office Application Serial No. 85304626 for registration of the mark DEFORD BAILEY in the category of “harmonicas.” Counsel of record for Applicant, Walter M. Benjamin, filed this application on behalf of Deford Bailey III despite the fact that Deford Bailey III had never spoken to Mr. Benjamin and did not authorize him to represent him or file the application on his behalf.

5. In actuality, Deford Bailey III did not join Carlos Bailey in filing the trademark application at issue. Attached is a true and correct copy of a letter from Deford Bailey III to Mr. Benjamin dated June 2, 2011, stating:

I understand that you have filed a federal trademark application on my behalf for the mark DEFORD BAILEY. I have never spoken with you or authorized you to represent me or file a trademark application on my behalf. I demand that you immediately withdraw the application.

Attached hereto as Exhibit B is a true and correct copy of a Declaration signed by Deford Bailey III in which he states under oath: “I have never met or communicated with Mr. Benjamin and did not authorize him to file the application on my behalf or represent me in connection with any legal matters.”

6. Mr. Benjamin was notified of this issue in correspondence dated May 26, 2011, and June 27, 2011, but has not withdrawn the application.

7. By filing the application on behalf of Deford Bailey III with no authorization to do so, Mr. Benjamin filed a false and fraudulent trademark application. He confirmed this fraud by his failure to withdraw the application despite an express request to do so by Deford Bailey III.

8. Mr. Benjamin’s filing violates the following applicable sections of the regulations governing attorney conduct in connection with federal trademark applications: First, when an attorney signs a document in a representative capacity and submits it to the U.S. Patent and Trademark Office (“Trademark Office”), his signature constitutes a representation to the Trademark Office that he is authorized to represent the person or entity on whose behalf he acts. 37 C.F.R. § 2.17(b). Further, by presenting such signed application to the Trademark Office, the attorney is certifying that “all statements made therein of the party’s own knowledge are true, all statements made

therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. § 1001 and any other applicable criminal statute, and violations of the provisions of [such] section may jeopardize the probative value of the paper.” 37 C.F.R. § 11.18(b). Finally, violations of this requirement may jeopardize the validity of the application. 37 C.F.R. § 2.193(f).

9. In addition, on or about April 18, 2012, Applicant Carlos Bailey entered into a Name and Likeness Licensing Agreement with Opposer (the “Agreement”). A true and correct copy of the Agreement is attached hereto as Exhibit C. The Agreement provides, in relevant part:

WHEREAS, the parties desire that CB [Carlos Bailey] pay Licensor [Opposer] for the use of DeFord Biley’s name and likeness in connection with CB’s marketing, sale, and distribution of products bearing the DeFord Bailey name, specifically, t-shirts and harmonicas.

1.1 “Licensed Property” means the name DEFORD BAILEY and the goodwill appurtenant thereto.

1.2 “Products” means the t-shirts and harmonicas marketed, sold, distributed, displayed, and/or produced by or for CB in existence as of the Effective Date [April 18, 2012] or created thereafter.

2.1 Grant of License. Licensors hereby grants to CB the non-exclusive license and right to use the Licensed Property in connection with the Products.

2.2 Reservation of Rights. Use of Licensed Property, and the goodwill associated therewith, shall inure solely to Licensors. Except for the license granted hereunder and as otherwise provided herein, (a) as between the parties, Licensors retains any right, title and interest in and to the Licensed Property, and (b) CB acknowledges and agrees that it will not have any right, title or interest in or to the Licensed Property, and CB shall not make any claim of ownership or interest in or to such Licensed Property.

10. In the Agreement, Applicant Carlos Bailey acknowledged Opposer's ownership of the name DEFORD BAILEY and its appurtenant goodwill. He acknowledged that he must have a license to use the name in connection with sale of harmonicas. Finally, he acknowledged that he has no interest in the name, and he agreed not to make any claims of ownership or interest in the name himself. By these admissions, Applicant Carlos Bailey has conceded that he had no right to file his application Serial No. 85304626 for the Mark in connection with harmonicas and that he does not have a legitimate ownership interest in the Mark.

11. DB LLC has a legitimate interest in the outcome of this proceeding, as it is the successor in interest to the name and likeness rights of harmonica virtuoso Deford Bailey and would be deprived of the right to use its intellectual property (the name DEFORD BAILEY) in connection with goods and services in the future. Carlos Bailey did not choose the mark DEFORD BAILEY in connection with harmonicas by happenstance; Carlos Bailey is the grandson of Deford Bailey and is attempting to exploit the fame of Deford Bailey as a harmonica virtuoso by use of his name in connection with

the sale of harmonicas. Indeed, Carlos Bailey admitted in his Amended Answer to Opposer's original Notice of Opposition that "he began referring to himself on stage as Carlos Deford Bailey instead of Carlos Bailey for the express purpose of promoting the name of [Deford Bailey,] Sr," and that he "began promot[ing] the name of [Deford Bailey,] Sr., deceased, by various means...." He also admitted expressly that he "decided to promote [Deford Bailey,] Sr. by selling harmonicas with the likeness of [Deford Bailey] thereon." Purchasers of harmonicas bearing the name DEFORD BAILEY, in light of Deford Bailey's fame in connection with this unique musical instrument, are likely to assume that harmonicas bearing the mark DEFORD BAILEY are connected with the Deford Bailey. DB LLC, as a successor to the late Deford Bailey's rights to his name and likeness, thus would be injured by the false suggestion of this connection.

12. Such registration and continued use of the mark DEFORD BAILEY consists of matter that falsely suggests a connection with the late Mr. Bailey, which is prohibited by Section 2(a) of the Trademark Act.

13. In addition, DB LLC has previously licensed the rights to use the mark DEFORD BAILEY in connection with harmonicas, T-shirts, and other commercial products. The registration and continued use of the mark DEFORD BAILEY by Applicants in connection with the applied-for goods is likely to cause confusion, deception, and mistake in violation of Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and will seriously damage DB LLC.

14. For the reasons described above, DB LLC has a reasonable basis for its belief in damage.

WHEREFORE, the Opposer, Deford Bailey LLC, prays that said application Serial No. 85304626 be rejected, that no registration be issued thereon to the Applicant, and that this opposition be sustained in favor of the Opposer.

Deford Bailey LLC has appointed Amy J. Everhart and Maria A. Spear of Everhart Law Firm PLC, 1400 Fifth Avenue North, Nashville, Tennessee 37208, (615) 800-8919, members of the bar of the State of Tennessee, to act as attorneys for Deford Bailey LLC herein, with full power to prosecute said Opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communications in connection with this Opposition.

Respectfully submitted,

Deford Bailey LLC, the Opposer

By: /Amy J. Everhart/
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Everhart Law Firm PLC
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Nashville, TN 37208
(615) 800-8919
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amy@everhartlawfirm.com
maria@everhartlawfirm.com

Attorneys for Opposer,
Deford Bailey LLC

Date: February 13, 2014

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served via electronic mail and U.S. Mail, postage prepaid, on this 13th day of February, 2014.

Walter M. Benjamin
P.O. Box 6099
Tulsa, OK 74148
wabenj@netzero.com

/Amy J. Everhart/

Amy J. Everhart

EXHIBIT A

June 2, 2011

Walter M. Benjamin
Attorney at Law
P. O. Box 6099
Tulsa, OK 74148-0099

Dear Mr. Benjamin:

I understand that you have filed a federal trademark application on my behalf for the mark DEFORD BAILEY. I have never spoken with you or authorized you to represent me or file a trademark application on my behalf. I demand that you immediately withdraw the application.

Sincerely,

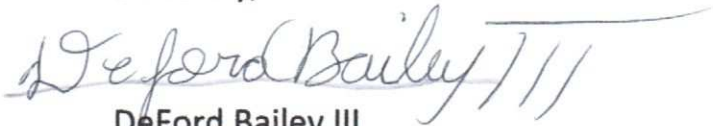

DeFord Bailey III



EXHIBIT B

DECLARATION OF DEFORD BAILEY III

I, DeFord Bailey III, of full age, hereby declare as follows:

1. I have learned that attorney Walter M. Benjamin has filed an application for registration of the trademark DEFORD BAILEY in connection with harmonicas with the U.S. Patent and Trademark Office, application number 85304626.

2. I have never met or communicated with Mr. Benjamin and did not authorize him to file the application on my behalf or represent me in connection with any legal matters.

I declare under penalty of perjury that the foregoing is true and correct. Executed this 2 day of June, 2011.

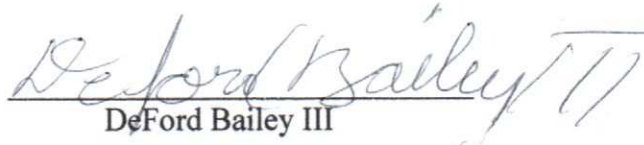
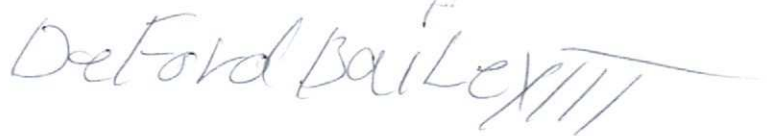

DeFord Bailey III


EXHIBIT C

NAME AND LIKENESS LICENSING AGREEMENT

THIS NAME AND LIKENESS LICENSING AGREEMENT (the "Agreement") is by and between DeFord Bailey LLC ("Licensor"), a Tennessee Limited Liability Company, and Carlos Bailey ("CB"). The effective date of this Agreement shall be April 18, 2012 (the "Effective Date").

WHEREAS, the parties desire that CB pay Licensor royalties for the use of DeFord Bailey's name and likeness in connection with CB's marketing, sale, and distribution of products bearing the DeFord Bailey name, specifically, t-shirts and harmonicas.

NOW, THEREFORE, in consideration of the mutual promises contained herein and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties hereto agree as follows:

1. Certain Definitions.

1.1 "Licensed Property" means the name DEFORD BAILEY and the goodwill appurtenant thereto.

1.2 "Products" means the t-shirts and harmonicas marketed, sold, distributed, displayed and/or produced by or for CB in existence as of the Effective Date or created thereafter.

2. License.

2.1 Grant of License. Licensor hereby grants to CB the non-exclusive license and right to use the Licensed Property in connection with the Products.

2.2 Reservation of Rights. Use of Licensed Property, and the goodwill associated therewith, shall inure solely to Licensor. Except for the license granted hereunder and as otherwise provided herein, (a) as between the parties, Licensor retains any right, title and interest in and to the Licensed Property, and (b) CB acknowledges and agrees that it will not have any right, title or interest in or to the Licensed Property, and CB shall not make any claim of ownership or interest in or to such Licensed Property.

3. Fees. CB shall pay Licensor royalties equal to twenty percent (20%) of the gross receipts derived from the sale of the Products. Payment of the royalty amounts shall be accompanied by reasonable written detail of the basis for the payment. Such royalty amounts shall be payable within fourteen (14) days of the sale of the Products.

4. Product Approval. CB shall provide Licensor with a sample of each Product before selling any such Product. Licensor has the right to refuse the sale of any such Product for any reason within Licensor's discretion.

5. **Representations and Warranties.** Each party represents and warrants that:

(a) it has full power (corporate or otherwise) and authority to enter into and perform its obligations under this Agreement, and all actions necessary to authorize the execution, delivery and performance of this Agreement have been taken by such party; and

(b) neither the execution and delivery of this Agreement nor the consummation of the transactions contemplated herein will conflict with or result in any breach of or event of termination under any of the terms of, or constitute a default under or result in the termination of or the creation or imposition of any encumbrance pursuant to, the terms of any contract or agreement to which it is a party or by which it or any of its assets and properties are bound.

6. **Term.** This Agreement shall commence on the Effective Date and may be terminated at any time upon written notice by either party. Upon termination, CB must cease the production of new Products including the Licensed Production but shall have three (3) months to sell off any (pre-approved) Products including the Licensed Property existing as of the date of termination.

7. **Indemnification.** Each party (the "Indemnifying Party") will indemnify, defend, and hold harmless the other party, and the other party's affiliates, subsidiaries, successors and assigns (as applicable), and any of their respective officers, directors, employees and agents (each, an "Indemnified Party"), from and against any and all damages, liabilities, costs and expenses, including reasonable legal fees and expenses, in any third party lawsuit or proceeding based upon or otherwise arising out of a breach or alleged breach of the Indemnifying Party's representations, warranties or covenants contained herein. Each Indemnified Party will (a) promptly notify the Indemnifying Party of such claim; (b) provide the Indemnifying Party with reasonable information, assistance and cooperation in defending the lawsuit or proceeding; and (c) give the Indemnifying Party full control and sole authority over the defense and settlement of such claim, subject to the Indemnified Party's approval of any such settlement, which approval will not be unreasonably withheld or delayed.

8. **Limitation of Liability.** EXCEPT FOR THE INDEMNIFICATION OBLIGATIONS HEREUNDER, NEITHER PARTY WILL BE LIABLE FOR ANY INDIRECT, SPECIAL, INCIDENTAL, CONSEQUENTIAL, EXEMPLARY OR PUNITIVE DAMAGES, INCLUDING BUT NOT LIMITED TO DAMAGES FOR LOST DATA, LOST PROFITS, LOST REVENUE, LOST BUSINESS, ANTICIPATED PROFITS OR COSTS OF PROCUREMENT OF SUBSTITUTE GOODS OR SERVICES, HOWEVER CAUSED AND UNDER ANY THEORY OF LIABILITY, INCLUDING BUT NOT LIMITED TO CONTRACT OR TORT (INCLUDING PRODUCTS LIABILITY, STRICT LIABILITY AND NEGLIGENCE), AND WHETHER OR NOT SUCH PARTY WAS OR SHOULD HAVE BEEN AWARE OR ADVISED OF THE POSSIBILITY OF SUCH DAMAGE AND NOTWITHSTANDING THE FAILURE OF ESSENTIAL PURPOSE OF ANY LIMITED REMEDY STATED HEREIN.

9. Miscellaneous.

8.1 Successors and Assigns. CB may not assign this Agreement without Licensor's consent. This Agreement shall be assignable by Licensor, and inure to the benefit of and be binding upon the successors, legal representative, heirs and assigns of Licensor. Except as explicitly specified in this Section, this Agreement is not assignable.


8.2 Third-Party Beneficiaries. Nothing in this Agreement, express or implied, is intended to confer upon any party, other than the parties hereto or their respective successors and permitted assigns, any rights, remedies, obligations or liabilities under or by reason of this Agreement, except as expressly provided in this Agreement.


8.3 Governing Law. This Agreement shall be governed by, and construed and enforced in accordance with, the laws of the State of Tennessee, without regard to principles of conflicts of law.

8.4 Severability. If one or more provisions of this Agreement are held to be unenforceable under applicable law, such provision shall be excluded from this Agreement and the balance of the Agreement shall be interpreted as if such provision were so excluded and shall be enforceable in accordance with its terms.

8.5 Entire Agreement. This Agreement constitutes the entire agreement of the parties with respect to the subject matter hereto and no party shall be liable or bound to another party in any manner by any warranties, representations or covenants except as specifically set forth herein. This agreement may not be amended except in a writing signed by both parties.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed as of the date first written above.


Deford Bailey LLC
By: Shemika Wiley, Member


Carlos Bailey